



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/796,016

03/10/2004

Francois Le Bourhis

06028.0045-00

2658

22852

7590

01/21/2010

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP

901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

SOROUGH, ALI

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

01/21/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/796,016	Applicant(s) LE BOURHIS ET AL.	
	Examiner ALI SOROUGH	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-9,14-23 and 28-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-9,14-23 and 28-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgement of Receipt

Applicant's response filed on 10/02/2009 to the Office Action mailed on 04/02/2009 is acknowledged.

Status of the Claims

Claims 2-3, 10-13, and 24-27 are cancelled and claims 1 and 30-32 are currently amended. Therefore, claims 1, 4-9, 14-23, and 28-32 are currently pending examination for patentability.

Rejections and/or objections not reiterated from the previous Office Action are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of rejections and/or objections presently being applied to the instant application.

New Grounds of Rejection

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.

Art Unit: 1616

3. Ascertaining the differences between the prior art and the claims at issue; and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 1, 4-9, 14-23, and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dupuis et al (US Patent Application 2004/0161387 A1, Published 08/19/2004) in view of Ashton et al (US Patent 6350433 B1, Published 02/26/2002) **is maintained.**

Applicant Claims

Applicant claims a aerosol device comprising a cosmetic composition comprising a polyurethane in a cosmetically acceptable medium comprising water and an organic solvent and a propellant comprising dimethyl ether and at least one C₃- C₅ hydrocarbons. Applicant further claims a method for shaping and/or holding a hairstyle and a hair lacquer using the aforementioned aerosol device.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

Dupuis et al. teach an aerosol device containing a hair composition. (See title). In a preferred embodiment the hair composition comprises 1% Luviset VPI K 61, 4% dimethylolpropionic acid/isophorone diisocyanate/neopentylglycol/polyesterdiols copolymer (Luvitec PUR), 40% water, 20% ethanol, and 35% dimethyl ether. (See paragraph 0157). The preferred composition can be packaged into an aerosol device and sprayed onto the hair and confer thereto a very good holding. (See paragraph 0158). "[T]he composition further comprises an adjuvant selected from the group consisting of silicones in soluble, dispersed or microdispersed form, nonionic, anionic,

Art Unit: 1616

cationic and amphoteric surfactants, ceramides and pseudoceramides, vitamins and provitamins including panthenol, vegetable, animal, mineral and synthetic oils, waxes other than ceramides and pseudoceramides, silicone or nonsilicone, water-soluble and fat-soluble sunscreens, coloured or noncoloured, inorganic and organic pigments, colorants, pearlescent and opacifying agents, sequestering agents, plasticizing agents, solubilizing agents, acidifying agents, alkalinizing agents, inorganic and organic thickening agents, antioxidants, hydroxy acids, penetrating agents, perfumes, preservatives, and mixtures thereof.” (See page 9, claim 17).

***Ascertainment of the Difference Between Scope the Prior Art and the Claims
(MPEP §2141.012)***

Dupuis et al. lacks a teaching of a propellant comprising both dimethyl ether and at least one n-butane. Ashton et al. cure the deficiency.

Ashton et al. teaches an autophobic hair spray composition comprising film forming resin such as carboxylated polyurethanes, propellant, and autophobic hair spray additive. (See title and column 2, Lines 64-65). “The hairspray resin employed in the composition of the present invention should be capable of forming a film and holding the hair of the user in place ...” (See column 2, Lines 15-17). “Compositions of the present invention include water. Typical water levels for an ethanol-based aerosol fixing spray are from 2 to 10%, usually about 2 to 6% by weight.” (See column 6, Lines 30-32). The composition can further include an adjuvant such as ceramides. (See column 7, Lines 21-39). Ashton et al. further teaches that propellant is a mixed propellant of

Art Unit: 1616

dimethyl ether and hydrocarbone selected from isobutane, n-butane, propane, and mixtures. (See column 3, Lines 64-67 and column 4, Lines 1-2). "The amount of propellant will range 3 to 50%, preferably from 5 to 45%, optimally from 25 to 45% by weight total composition. Weight ration of total hydrocarbon to dialkyl ether will range from 5:1 to 1:10, preferably from 2:1 to 1:5, more preferably from 1:1 to 1:4, optimally about 1:2 by weight." (See column 4, Lines 9-11).

***Finding of Prima Facie Obviousness Rational and Motivation
(MPEP §2142-2143)***

It would have been obvious to one of ordinary skill in the art to combine Dupuis et al. with Ashton et al. One would have been motivated to do because Dupuis et al. teaches that a mixture of propellants may be used for delivering a polyurethane composition. Further, Ashton et al. teaches a composition that comprises carboxylated polyurethanes for hair fixing. For the foregoing reasons the instant device would have been obvious to one of ordinary skill in the art at the time of the instant invention.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

Art Unit: 1616

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Soroush whose telephone number is (571) 272-9925. The examiner can normally be reached on Monday through Thursday 8:30am to 5:00pm E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

Application/Control Number: 10/796,016

Page 7

Art Unit: 1616

Customer Service Representative or access to the automated information system, call
800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ali Soroush
Patent Examiner
Art Unit: 1616

/Johann R. Richter/

Supervisory Patent Examiner, Art Unit 1616